

Fw



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,429	06/29/2001	Gordon Scott Scholler	HO-P02234US0	8238

26271 7590 01/31/2003
FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/896,429

Applicant(s)
Scholler et al. *MF*

Examiner
A. Farah

Art Unit
3739



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 1, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 and 8 6) ☐ Other:

Art Unit: 3739

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 7 and 13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 29 and 33 of copending Application No. 09/772,539. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

Art Unit: 3739

art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (U.S. Patent No. 5,549,632) in view of Swinger et al. U.S. Patent No. 6,325,792 B1) and in view of Davidson (U.S. Patent No. 5,282,088).

Lai discloses ophthalmic surgery apparatus and method for determining and controlling the location of interaction point between a patient's eye and surgical laser beam, the apparatus comprising:

an interface **109** adapted to couple the patient's eye to a surgical laser **100** (see Fig. 1);

an attachment means **115** adapted to overlay the anterior surface of the eye to provide stable engagement to the eye (see Fig. ¹3); and

an applanation lens **111** mounted to the attachment means (see Fig. 4C), the applanation lens having an applanation surface configured to contact the eye, and therefore, applanate or flatten the anterior surface of the eye upon application of pressure.

As to claims 13-18, Fig. 4C of Lai teaches the use of a suction ring **501** adapted to the bottom surface of the interface so as to stabilize the position of the interface relative to the operative area of the eye. *Guipart*

Lai further teaches that his laser provides a laser beam suitable for ophthalmic surgery (see Claim 1, lines 4-5). However, although he describes the use of various known ophthalmic surgery lasers, which would provide the wavelength ranges of the instant claims (i.e., 275 nm -

Art Unit: 3739

2500 nm), he does not particularly specify the type of laser used with his invention. He further fails to teach the material in which the applanation lens is made of, or its relative transmission in the laser wavelength.

Swinger et al. teach an alternative ophthalmic surgical apparatus and method comprising: an ultraviolet (UV) laser **52**, which provides the ablation energy (see Col. 28, lines 8-17); and an applanation lens **78** having an applanation surface configured to contact the patient's eye (see Fig. 15D; and Col. 26, lines 21-27). Their applanation lens transmits the ablative laser beams produced by the UV laser. However, although their applanation lens is configured to transmit the irradiated UV, they do not teach the material in which the lens is being formed.

Davidson teaches an applanation lens which has no, or negligible, spherical aberration on or near its axis. He teaches that if the lens is made from a fused silica, then it is transparent in the UV, down to about 180 nm. In this Office Action, the lens of Davison, which is made from a material that is analogous to materials of the instantly claimed lens, is treated to have 'a purity great enough to resist discoloration upon prolonged irradiation produced by high energy irradiation sources such as UV, X-rays, gamma rays, etc.'

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Lai with Swinger et al. and use a UV laser as an alternative source to provide the ablation energy. The use of UV-grade lenses to transmit the maximum intensity/energy of an irradiated UV light is ⁿ well knowⁿ ^{in the} art. Hence, it would have been further obvious to one skilled in the art to modify Lai with Swinger et al. and in view of Davidson to

JW
10/03

Art Unit: 3739


make the applanation lens from a fused silica or material that transmits UV light, and withstands prolonged high-energy irradiation such as UV, X-rays, or gamma rays in order to avoid discoloration/degradation that may be subjected to the lens. The use of such lens would maintain/prolong the integrity of the lens, and therefore, would be cost effective. It would further eliminate the time needed to re-align a surgical system with an ordinary glass lens in the case the lens is damaged and its focusing properties changed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

A. M. Farah

Patent Examiner (Art Unit 3739)


January 25, 2003


Linda C. M. Dvorak

Supervisory Patent Examiner